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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,171

05/06/2005

Paola Branduardi

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03/03/2009

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EXAMINER

VOGEL, NANCY TREPTOW

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,171	Applicant(s) BRANDUARDI ET AL.	
	Examiner NANCY VOGEL	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24-30, 32, 34, 36 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24-30, 32, 34, 35 and 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 22, 24-30, 32, 34, 36, 38-41 are pending in the case.

Response to Amendment

Any rejection of record in the previous action not addressed in this office action is withdrawn. There are no new grounds of rejection that were not necessitated by applicants' amendment and therefore, this action is final.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 22, 24-26, 28-31, 34, 35, 36, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brambilla et al. (WO 00/41477) in view of Brake et al. (PNAS 81, 4642-4646, 1984) or Stark et al. (EMBO J. 5, 1995-2002, 1986).

This rejection is maintained essentially for the reasons made of record in the previous Office action mailed 7/24/08.

Applicants have argued that there would not have been a reasonable expectation of success in using the teachings of Brake and Stark in the Z Bailii expression system taught by Brambilla. Applicants argue that either of Brake or Stark references teach secretion from other yeast genera, and that one of ordinary skill in the art is aware that yeast of different species are expected to have structural and functional differences. However, it is maintained that it is routine in the art to use signal

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sequences from differing organisms to direct secretion from an organism of choice, and there would have been a reasonable expectation of success using a secretion sequence from a yeast type of cell in another yeast cell. There is no reasons to have expected that such a sequence would not function in a different cell type. Therefore, the rejection is maintained.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brambilla in view of Brake or Stark and further in view of) as applied to claim s 22, 24-26, 28-31, 32, 34, 36, 39-41 above, and further in view of Jacobson et al. (WO 92/04461.

This rejection is maintained essentially for the reasons set forth in the previous Office action, mailed 7/24/08.

Applicants have argued that the rejection should be withdrawn for the reasons set forth regarding base claim 22, and furthermore, since Jacobson fails to give any information regarding secretion of proteins from yeast. However, Jacobson was not cited for teaching secretion of proteins from yeast, but rather, for its teaching of the DNA sequence which comprises at least 35 nucleotides of the sequence shown in SEQ ID NO:69, which encodes a particular antigen. Since Brambilla discloses that the *Z. bailii* yeast has advantages for the expression of proteins of interest, one would have been motivated to express the protein disclosed by Jacobson using this yeast. Therefore, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636

NV
3/2/09